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OFFICE OF PETITIONS

In re Application of :
Benneker et al :
Application No. 09/200,743 : **DECISION ON PETITION**
Filed: November 30, 1998 :
Attorney Docket No. 116.065 :

This is a decision on the petition under 37 CFR 1.182, filed, November 22, 2006, to withdraw the Terminal Disclaimer dated January 31, 2001.

The petition is **DISMISSED**.

In response to a final office action dated May 4, 2000, applicant filed a Continuing Prosecution Application (CPA) in November 27, 2000. Subsequently, and before an office action was issued by the examiner, applicant on January 31, 2001, filed additional papers, including a Terminal Disclaimer. Specifically, applicant submitted a Terminal Disclaimer over Benneker et al patent 5,874,447 which issued from the grandparent of the instant application. Applicant's remarks reasoned that the Terminal Disclaimer avoids any issue of obviousness double patenting between claim 7 of the patent and claim 39 of the instant application. On February 13, 2001, the Terminal Disclaimer was approved. On May 31, 2001, applicant canceled claim 39 of the instant application without prejudice or disclaimer of the subject matter thereof.

On August 1, 2001, the examiner advised applicant that the application was allowable, but for the suspension of the case for a potential Interference, an Interference which was concluded in applicant's favor on May 25, 2004. Upon return of the case from the Board of Appeals and Interferences, applicant submits this 37 CFR 1.182 petition to withdraw the Terminal Disclaimer on the position that since the subject matter of claim 39 has been canceled, there is no longer a need for the Terminal Disclaimer.

Since no obviousness double patenting rejection was given during the prosecution, assessment of the current claims against applicant's patent 5,874,447 by the examiner of record was necessary. Upon inquiry, the current assessment by the examiner reasons that the Terminal Disclaimer

remains necessary. In particular, the examiner has concluded that the Terminal Disclaimer should not be removed because the narrow, instantly claimed process, would be fully embraced by the process allowed in patent 5,874,447. The examiner reasoned that comparing claim 32 of the application with claim 1 of the patent the instant application represent a species of the issued genus, hence necessitating the presence of the Terminal Disclaimer in this application.

There are at least two reasons for insisting upon a terminal disclaimer to overcome a nonstatutory double patenting rejection in a continuing application subject to a 20-year term under 35 U.S.C. 154(a)(2). First, 35 U.S.C. 154(b) includes provisions for patent term extension based upon prosecution delays during the application process. Thus, 35 U.S.C. 154 does not ensure that any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will necessarily expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). Second, 37 CFR 1.321(c)(3) requires that a terminal disclaimer filed to obviate a nonstatutory double patenting rejection based on commonly owned conflicting claims include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection.

Second, 37 CFR 1.321(c)(3) requires that a terminal disclaimer filed to obviate a nonstatutory double patenting rejection based on commonly owned conflicting claims include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection. 37 CFR 1.321(d) sets forth the requirements for a terminal disclaimer where the claimed invention resulted from activities undertaken within the scope of a joint research agreement. These requirements serve to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention. See, e.g., *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982). Not insisting upon a terminal disclaimer to overcome a nonstatutory double patenting rejection in an application subject to a 20-year term under 35 U.S.C. 154(a)(2) would result in the potential for the problem that 37 CFR 1.321(c)(3) was promulgated to avoid.

In view of the above, the petition under § 1.182 to withdraw the Terminal Disclaimer cannot be granted.

As authorized, the \$400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's deposit account.

This application is being referred to Technology Center 1600 for further processing.

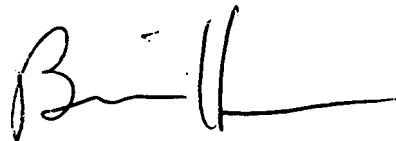
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Any questions concerning this matter may be directed to Thurman K. Page at (571) 272-0602.

A handwritten signature in black ink, appearing to read 'Brian Hearn', with a long horizontal stroke extending to the right.

Brian Hearn
Petition Examiner
Office of Petitions